



UNITED STATES PATENT AND TRADEMARK OFFICE

JK

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------------------------------------------------------------------------------------------|-------------|----------------------|---------------------|------------------|
| 09/978,261 | 10/15/2001 | David Y. Zhang | 251305.0028 SBP/MCD | 4119 |
| 7590 | 05/10/2005 | | EXAMINER | |
| Steven B. Pokotilow, Esq. Stroock & Stroock & Lavan LLP 180 Maiden Lane New York, NY 10038 | | | LU, FRANK WEI MIN | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1634 | |

DATE MAILED: 05/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/978,261

Applicant(s)

ZHANG, DAVID Y.

Examiner

Frank W. Lu

Art Unit

1634

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires _____ months from the mailing date of the final rejection.
 b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
 Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
 (a) They raise new issues that would require further consideration and/or search (see NOTE below);
 (b) They raise the issue of new matter (see NOTE below);
 (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicant's reply has overcome the following rejection(s): _____.

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 40-52.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

- _____
12. Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. Other: _____

DETAILED ACTION

ADVISORY ACTION

1. The proposed amendments filed on April 27, 2005 have been fully considered but will not be entered because: (1) they raise new issues that would require further consideration and/or search; and (2) they raise the issue of new matter.

Response to Arguments

I. In page 6, fourth and fifth paragraphs of applicant's remarks, applicant argues that double patent rejection has been overcome by filing a terminal disclaimer with respect to copending application No. 10/719,480.

The examiner agrees to withdraw this rejection if the office approves the terminal disclaimer.

II. In page 7, second paragraph bridging to page 10, third paragraph of applicant's remarks, applicant argues that the amendments on claim 47 have overcome the rejection under 35 USC 102 (b).

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection because applicant's argument with respect to the rejection is moot since applicant has amended claim 47. For example, the phrase "wherein detection of an increase in the signal indicates the presence of the target nucleic acid in the sample" in step (d) of the amended 47 raises new issues that would require further consideration and/or search because claim 47 filed on December 6, 2004 does not require to detect an increase in the signal. Furthermore, the phrase "wherein detection of an increase in the signal indicates the presence of the target nucleic acid in

the sample" in step (d) of the amended 47 raises the issue of new matter because page 63, lines 13-15 of the specification as suggested by applicant does not support this limitation.

III. In page 10, last paragraph bridging to page 12, first paragraph of applicant's remarks, applicant argues the amendments on claim 40 have overcome the rejection under 35 USC 102 (b).

This argument has been fully considered but it is not persuasive toward the withdrawal of the rejection because applicant's argument with respect to the rejection is moot since applicant has amended claim 40. For example, the phrase "wherein detection of an increase in the signal indicates the presence of the target nucleic acid in the sample" in step (d) of the amended 40 raises new issues that would require further consideration and/or search because claim 40 filed on December 6, 2004 does not require to detect an increase in the signal. Furthermore, the phrase "wherein detection of an increase in the signal indicates the presence of the target nucleic acid in the sample" in step (d) of the amended 47 raises the issue of new matter because page 63, lines 13-15 of the specification as suggested by applicant does not support this limitation.

2. Papers related to this application may be submitted to Group 1600 by facsimile transmission. Papers should be faxed to Group 1600 via the PTO Fax Center. The faxing of such papers must conform with the notices published in the Official Gazette, 1096 OG 30 (November 15, 1988), 1156 OG 61 (November 16, 1993), and 1157 OG 94 (December 28, 1993)(See 37 CAR § 1.6(d)). The CM Fax Center number is (571)273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Lu, Ph.D., whose telephone number is (571)272-0746. The examiner can normally be reached on Monday-Friday from 9 A.M. to 5 P.M.

Art Unit: 1634

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (571)272-0745.

Any inquiry of a general nature or relating to the status of this application should be directed to the Chemical Matrix receptionist whose telephone number is (703) 308-0196.

Frank Lu
PSA
May 5, 2005

Frank Lu
FRANK LU
PATENT EXAMINER